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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,192

03/05/2007

Marc Husemann

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27386

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10/27/2010

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EXAMINER

FIGUEROA, JOHN J

ART UNIT

PAPER NUMBER

1765

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/581,192	<b>Applicant(s)</b> HUSEMANN ET AL.	
	<b>Examiner</b> John J. Figueroa	<b>Art Unit</b> 1765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The §35 U.S.C. 112, second paragraph, rejection of claim 6 previously made of record in item 5 on page 3 of the Office Action dated May 11, 2010 (hereinafter 'OA') has been withdrawn in view of Applicant's amendment to said claim in the response to OA filed August 9, 2010 (hereinafter 'Response').
2. The 35 U.S.C. §102(b) rejection of 1-3 and 6-13 as anticipated by European Patent Office Patent Number 1 308 492 A1 to Schumann et al. (exemplified by USPN 6,958,186 B2 to Husemann, hereinafter 'Husemann') has been maintained for reasons previously made of record in item 7 on page 3 of OA and set forth below in the instant action.

### ***Election/Restrictions***

3. Applicant's election with traverse of polyester as the species to be examined for the thermoplastic polymer in the first layer of the pressure-sensitive adhesive ('psa') (in response to restriction requirement of 11/09/2009) had been acknowledged in item 1 of OA.
4. This restriction requirement is still deemed proper and has therefore been made FINAL. Accordingly, claims 1-13 are pending. Claims 1-3 and 6-13 have been

examined in the instant action whereas claims 4 and 5 have been withdrawn as drawn to a non-elected species but remain in the current application.

### ***Response to Arguments***

#### ***The 35 U.S.C. §112, Second Paragraph, Rejection (item 5 of OA)***

5. Applicant's arguments in Response regarding the captioned indefiniteness rejection of claim 6 have been considered but have become moot due to the withdrawal of this rejection in view of the amendment to this claim in Response.

#### ***The 35 U.S.C. §102 Rejection over Husemann (item 7 of OA)***

6. Applicant's arguments filed in Response regarding the captioned 35 U.S.C. 102 anticipation rejection of claims 1-3 and 6-13 (as currently amended) over Husemann have been fully considered but deemed unpersuasive.

Applicant's principal arguments in Response traversing the instant anticipation rejection is that the current amendment to independent claim 1 limiting the pressure sensitive adhesive to a "two-layer pressure sensitive adhesive *comprising* a first pressure sensitive adhesive layer and *joined* to a second pressure-sensitive adhesive layer" overcomes Husemann.

First, although the term "joined" is not explicitly defined in the present specification, however, on page 3, lines 18-19 the specification states that "in one preferred embodiment of the PSA of the invention layers A and B are joined to one another by means of physical or chemical pretreatment of layer A." Accordingly, in

accordance with the present specification, the term “joined” encompasses PSA having layers A and B connected by other layers present in the PSA.

As to the “two-layer pressure-sensitive adhesive” phrase in the claims’ preamble, Applicant is respectfully reminded that independent claim 1, as currently amended, still recites “comprising” language as its transitional phrase language, which is treated as an open-ended transitional phrase. Thus, the preamble of the present claims is interpreted as a pressure sensitive adhesive that *comprises* at least two layers (and can further contain other layers) in accordance with providing the broadest reasonable interpretation to the current preamble of the claims. See, MPEP 2111.03:

“The transitional phrases “comprising”, “consisting essentially of” and “consisting of” define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim.

The transitional term “comprising”, which is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) (“like the term comprising,’ the terms containing’ and mixture’ are open-ended.”). *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) (“The transition ‘comprising’ in a method claim indicates that the claim is open-ended and allows for additional steps.”); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) (“Comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) (“comprising” leaves “the claim open for the inclusion of unspecified ingredients even in major amounts”). In *Gillette Co. v. Energizer Holdings Inc.*, 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91

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(Fed. Cir. 2005), the court held that a claim to “a safety razor blade unit comprising a guard, a cap, and a group of first, second, and third blades” encompasses razors with more than three blades because the transitional phrase “comprising” in the preamble and the phrase “group of” are presumptively open-ended. “The word comprising’ transitioning from the preamble to the body signals that the entire claim is presumptively open-ended.” *Id.* In contrast, the court noted the phrase “group consisting of” is a closed term, which is often used in claim drafting to signal a “Markush group” that is by its nature closed. *Id.* The court also emphasized that reference to “first,” “second,” and “third” blades in the claim was not used to show a serial or numerical limitation but instead was used to distinguish or identify the various members of the group. *Id.*

As discussed in item 7 of OA, Husemann discloses a pressure-sensitive adhesive multilayered tape “comprising” a heat-activatable adhesive/polyester layer A “joined” to a crosslinked polyurethane carrier material containing layer B. Consequently, the present claims, as currently amended, still reads on Huseman’s disclosed multilayered PSA tape, particularly, in view of the open-ended transitional phrase language in the present claims.

Thus, the instant claims, as currently amended, remain anticipated by Husemann.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571)272-8916. The examiner can normally be reached on Monday-Thursday 8:00-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John J. Figueroa /  
Examiner, Art Unit 1765

JJF/JJS